

PATENT
Atty. Dkt. No. ROC920000014US1
MPS Ref. No.: IBM2K0014

REMARKS

This is intended as a full and complete response to the Final Office Action dated April 29, 2005, having a shortened statutory period for response set to expire on July 29, 2005. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 3-4, 6-9, 12, 13, 15-18, 21, 22 and 24-33 are pending in the application. Claims 3-4, 6-9, 12, 13, 15-18, 21, 22 and 24-33 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 103

Claims 3-4, 12-13, 21-22 and 28-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Travis* (U.S. Patent No. 5,604,897) in view of *Fein et al.* (U.S. Patent No. 5,940,847, hereinafter *Fein*). The Examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined *Fein* into *Travis* to have created the claimed invention. Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third criteria.

As discussed in previous response, *Travis* discloses a method and system for correcting misspelled words in a word processing document utilizing a dictionary file and a corrected before file. (Col. 2, Lns. 56-58). The corrected before file, which may be updated by the user, contains a list of misspelled words and the associated correctly spelled words. (Col. 2, Lns. 65-67). The *Travis* spell checker program checks each word of the document against a list of words in the dictionary file to determine whether

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the respective word is misspelled and checks each misspelled word against a list of misspelled words in the corrected before file. (Col. 3, Lns. 27-50). *Fein et al.*, as discussed in the previous response, discloses a system and method for automatically correcting multi-word data entry errors.

The cited references, alone or in combination, fail to teach, show or suggest the steps for identifying problem words in a document as claimed in independent claims 3, 12, and 21, i.e., recording the pre-edited contents and the post-edited contents of the document and then comparing the pre-edited contents of the document to the post-edited contents of the document to identify the problem words and replacement words. The references cited by the examiner determine misspelled words or phrases by comparison against a dictionary and corrected before file (in *Travis*) or a substitution list (in *Fein*). Thus, the cited references, alone or in combination, fail to teach, show or suggest the method for providing user-specific error analysis for identifying problem words (i.e., any correctly spelled words of a document that are improperly used as) recited in the independent claims.

In response to Applicants' arguments in the previous response, the Examiner states that:

Travis teaches in col. 2 lines 50-53 that the corrected before file may be updated by a user. The Examiner believes that Travis does teach the broadest reasonable interpretation of recording pre-edited contents and the post-edited contents of the document and then comparing the pre-edited contents to the post edited contents to identify the problem words and replacement words. Since Travis teaches allowing a user to update the corrected before file, Travis allows a user to identify a misspelled word and that word is saved as pre-edited contents. Travis then allows the user to edit the word and save the edited version of the word as post-edited contents. Now that the word has been edited and a corresponding post-edited contents is saved, the word is identified as a problem word and saved in the corrected before file along with the post-edited version of the word. Travis then provides teachings as to how the pre-edited contents are used to automatically identify problem words in another document and also teachings how the post-edited contents are used to automatically correct the problem words identified in said another document. Thus, the Examiner maintains that Travis teaches recording pre-edited contents and the post-edited contents of the document and then comparing the pre-edited contents to the post-edited contents to identify the problem words and replacement words as defined in the claimed invention.

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Applicants submit that the Examiner's analysis still lacks the step of comparing the pre-edited contents of the document to the post-edited contents of the document to identify the problem words and the replacement words. *Travis* discloses that a corrected word may be added by a user to the corrected before file. (Col. 4, lines 16-19). However, such addition is not based on a comparison of the pre-edited contents of the document to the post-edited contents of the document, but rather, it is a user option to add a user correction to the corrected before file. Furthermore, *Travis* does not teach, show or suggest identifying "problem words" which are defined in the claims as any correctly spelled words of a document that are improperly used. Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Claims 6-7, 15-16 and 24-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Travis* in view of *Fein*, and further in view of *Grover et al.* (U.S. Patent No. 5,818,437, hereinafter *Grover*). As discussed above, *Travis* in view of *Fein* is believed to be overcome for the reasons described above. Accordingly, the present rejection over *Travis* in view of *Fein*, and further in view of *Grover* is also believed to have been overcome.

Claims 8-9, 17-18 and 26-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Travis* in view of *Fein*, and further in view of *Cai et al.* (U.S. Patent No. 6,175,834, hereinafter *Cai*). As discussed above, *Travis* in view of *Fein* is believed to be overcome for the reasons described above. Accordingly, the present rejection over *Travis* in view of *Fein*, and further in view of *Cai* is also believed to have been overcome.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

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If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact the undersigned attorney to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted,



Randol W. Read
Registration No. 43,876
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants